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Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS, COOPER AND COMPANY.

PETITION FOR WRIT OF CERTIORARI—BRIEF

FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.

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THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

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PETITION FOR WRIT OF CERTIORARI

May it please the Court:

The petition of The United States Printing and Lithograph Company respectfully shows to this Honorable Court:

That the Supreme Court of the State of Ohio found that

I. The plaintiff had used its trade-mark "Home Brand" prior to and since the year 1901, upon groceries, in Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington. (Rec., p. 8);

II. The plaintiff conceded that its trade did not extend beyond these states (Rec., p. 12);

III. The plaintiff had registered its trade-mark "Home Brand" in the United States Patent Office under the trade-mark Act of 1905 (Rec., p. 9);

IV. The defendant (petitioner) for many years had printed labels on which the word "Home" appeared in combinations such as "Harvest Home," "Homestead," "Home Town," etc., and had sold them to its customers, who were grocers, located in states to which plaintiff's trade did not extend, namely, Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana (Rec., p. 8);

V. "The purpose and effect of the statute" (trade-mark Act of 1905) "was to project the trade-mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." • • • and • • • "There is ample ground for the contention that the purpose of the passage of the Act of 1905 was to put trade-marks on the same basis as patents, and to afford them like protection." (Rec., p. 16.)

The Court's attention is called to the fact that, though seven Justices sat in the case, three only concurred in this ruling. (Rec., p. 17.)

VI. The judgment finding plaintiff entitled to an injunction against defendant's printing said labels for its customers, is affirmed. (Rec., p. 17.)

REASONS ADVANCED FOR ALLOWING THE WRIT

The Supreme Court of Ohio in deciding that registration of a trade-mark under the trade-mark act of 1905, projects the right of the registrant into states, in which he had done no business and in advance of his trade, has decided a

federal question of substance not theretofore determined by this Court, and in a way probably not in accord with the decisions of this Court, in considering earlier trade-mark statutes.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Supreme Court of the State of Ohio, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 20435, The United States Printing and Lithograph Company, plaintiff in error, vs. Griggs, Cooper and Company, defendant in error, and that the said judgment of the Supreme Court of the State of Ohio may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioners will ever pray.

THE UNITED STATES PRINTING AND
LITHOGRAPH COMPANY,
By FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.

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THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

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vs.

GRIGGS, COOPER AND COMPANY.

BRIEF

This case was decided by the Supreme Court of Ohio upon June 20, 1928. (Rec., p. 6.)

The opinion is printed at page 7 of the Transcript of Record.

The ruling made therein, which is relied upon as the basis of the Court's jurisdiction, is that the effect of the United States Trade-Mark Act of 1905 "was to project the trade-mark rights of the registrant and owner thereof into all the states, even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner." (Rec., p. 16.)

The effect of this ruling is that a grocer who had sold his goods under the name "Home" solely in the north-western states, by securing registration of the word in the Patent Office, could prevent grocers, who had been selling their goods under names such as "Harvest Home" and "Home Run," in states remote from the north-western states, from getting labels printed for use on their goods, under their trade-marks.

This Court has decided how trade-mark rights are created, and what the powers of Congress, over these rights are, but has not had before it, the specific question, as to whether the Trade-Mark Act of 1905 extended the trade-mark rights of a registrant into states in advance of the extension of the trade therein. It is thought, however, that the decisions of this Honorable Court, in construing earlier trade-mark acts, indicate that the Trade-Mark Act of 1905 can not have the effect given to it by the Supreme Court of Ohio in this case.

This Court has decided that:

A

The property in trade-marks and the right to their exclusive use rest on the laws of the states. In Trade-Mark Cases, 100 U. S. at page 93, Mr. Justice Miller said:

> "The property in trade-marks and the right to their exclusive use resting on the laws of the states in the same manner that other property does, and depending, like the great body of the rights of person and of property, for their security and protection on those laws, the power of Congress to legislate on the subject, to establish the conditions on which these rights shall depend, the period of their duration, and the legal remedies for their protection, if such power exist at all, must be found in some clause of the Constitution of the United States, the instrument which is the source of all the powers that Congress can lawfully exercise."

B

That trade-mark rights, resting on the laws of the states, are limited to states in which the trade-marks are used.

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403.

In *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. at page 425, Mr. Justice Holmes (concurring) said:

> "The question then is, what is the common law of Alabama in cases like these? It appears to me that if a mark previously unknown in that state has been used and given a reputation there, the state may well say that those who have spent their money innocently in giving it its local value are not to be defeated by proof that others have used the mark earlier in another jurisdiction more or less remote."

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. at page 100, Mr. Justice Pitney said:

> "Property in trade-marks and the right to their exclusive use rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate upon the subject being only such as arises from the authority to regulate commerce with foreign nations and among the several states and with Indian tribes. (Page 98.) • • •
>
> It would be a perversion of the law of priority to give it such an application in our broadly extended country, that an innocent party, who had in good faith employed a trade-mark in one state, and by use of it had built up a trade there, being the first appropriator in that jurisdiction, might afterwards be prevented from using it with consequent injury to his trade and good-will at the instance of one who theretofore had employed the same mark, but only in other and remote jurisdictions, upon the ground that its first employment happened to antedate that of the first mentioned trader."

C

That Congress has been given no right to legislate upon the substantive law of trade-marks.

Trade-Mark Cases, 100 U. S. 93.
American Steel Foundries v. *Robertson*, 269 U. S. 372.

In *Trade-Mark Cases,* 100 U. S. 93, speaking of the United States Trade-Mark Act of 1870, Mr. Justice Miller said at page 96:

> "There still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same state, is beyond the control of Congress.
>
> When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the statute, or from its essential nature, that it is a regulation of commerce with foreign nations, among the several states, or with the Indian tribes. If it is not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade; to commerce at all points, especially if it is apparent that it is designed to govern the commerce wholly between citizens of the same state, it is obviously the exercise of a power not confided to Congress."

And in *Hanover Star Milling Co.* v. *Metcalf,* Mr. Justice Pitney said at page 416, 240 U. S.

> "And so far as the controversy concerns intrastate distribution as distinguished from interstate trade, the subject is not within the sovereign powers of the United States."

It is submitted that the ruling of the Supreme Court of Ohio, that registration under the Trade-Mark Act of 1905 extends the rights of the registrant into states in which registrant has done no business, is not in accord with decisions of this Court classified above under headings A, B and C.

CONCLUSION

It is respectfully submitted that this case is one that calls for the exercise by this Court of its supervisory power in order that the question as to whether registration under the 1905 Trade-Mark Act creates rights of the registrant in states in which he has done no business, may be authoritatively decided, and that to such an end a writ of certiorari should be granted and that this Court should review the decision of the Supreme Court of Ohio and reverse it.

Respectfully,

FRANK F. DINSMORE,
WALTER F. MURRAY,
Counsel for Petitioner.